



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/473,300	12/28/99	HONBO	H 503.34465VC3

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EXAMINER

HENDRICKSON, S

ART UNIT

PAPER NUMBER

1754

DATE MAILED:

10
12/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/473,300

Applicant(s)

HONBO ET AL.

Examiner

Stuart Hendrickson

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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The requirement for restriction made in paper no. 8 is repeated herein with the following modifications:

- 1) Group I is classifiable in class 23 subclass 293R.
- 2) Group II is classifiable in class 423, subclass 461.
- 3) New claim 23 is to be examined only if Groups I or II are elected, and will be examined only while it continues to read upon the elected specie, in the same manner as claims 7-9 have been treated.
- 4) New claims 24 and 26 are to be examined with either claim 20 or 21, in the above manner.
- 5) New claims 25 and 27 are to be examined with either 15 or 19, in the above manner.

That claim 24 depends upon claim 23 is of no moment, since the graphite powder can be made in several ways (as evidenced by the claims themselves). Therefore, graphite however made can be used in a battery/cell/electrode. The graphite itself can be used in a materially different manner other than in a batter/cell/electrode; it can be a heat shield. Similarly, the battery of claim 25 can be manufactured in a method other than by claim 24, as evidenced by the claims themselves. So too with the other claims, for the reasons given herein and in the original requirement.

The arguments traversing the requirement overlook the fact that the graphite can be made and used in more than one way, and the resulting electrode/cell/battery can also be made in materially different ways, as evidenced by the claims themselves. Further, the electrodes, regardless of how made, can be used in different types of cells (aqueous or nonaqueous, secondary or non-secondary). If applicant re-elects the same group, then claims 1-4 and 23 would be examined, so long as the correct part of claim 23 were to be removed. The claims recite differing limitations, ingredients, conditions and steps- different enough to create a burden of search and consideration of these limitations. While 'linked', the claims are still distinct- the

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mere filing of generic claim 23 does not make claims 1-4 and 5-6 into one grouping. By that logic, applicant could file one huge claim containing a verbatim copy of claim 1, the word 'or', a verbatim copy of claim 2, the word 'or', a verbatim copy of claim 3, etc. and say that all the claims were 'linked'. The argument that the allowance of claim 23 would result in the allowance of claim 1-6 is faulty because claim 23 could not be examined as it stands, since it involves two materially different processes which are the subject of restriction/election of species.

Applicant should remember to pay the fees for the additional claims.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.

A handwritten signature in black ink, appearing to read 'Stuart Hendrickson', is positioned above the printed name.

Stuart Hendrickson
examiner Art Unit 1754